REMARKS

By this Amendment, Applicants amend claims 1-6, 9-13, 17, 21, 22, 24, 25, 27, and 31 to more appropriately define the present invention. Claims 1-32 remain pending in this application.

At the outset, Applicants thank the Examiner for the courtesies extended to Applicants' representative during the telephone interview of February 22, 2005. During the interview, the patentability of the pending claims over the prior art was discussed with the Examiner.

In the Office Action,[1] the Examiner rejected claims 1, 2, 4-6, 9, 10, 12, 13, 21, 24, and 31 under 35 U.S.C. § 102(e) as being anticipated by Bull et al. (U.S. Patent No. 5,995,943); rejected claims 3, 7, 11, 14, 15, 22, and 25 under 35 U.S.C. § 103(a) as being obvious over Bull; rejected claims 8, 16, 23, and 26 under 35 U.S.C. § 103(a) as being obvious over Bull in view of Kirsch et al. (U.S. Patent No. 6,189,030); rejected claims 17-19, 27-29, and 31 under 35 U.S.C. § 103(a) as being obvious over Bull in view of Murray (U.S. Patent No. 6,061,659); and rejected claims 19, 20, 29, 30, and 32 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray and further in view of Kirsch.

Applicants respectfully traverse the rejection of claims 1, 2, 4-6, 9, 10, 12, 13, 21, 24, and 31 under 35 U.S.C. § 102(e) as anticipated by Bull. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

and every element of the claim in issue, either expressly described or under principles

of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must

be shown in as complete detail as is contained in the . . . claim." *See* M.P.E.P. § 2121

(8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9

U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as

required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 1 recites an "apparatus for hyperlinking specific words in content to turn

the words into advertisements" including, among other things, "an ad server connected

to the Internet, wherein the ad server provides means for providing a hypertext anchor

to convert at least one existing advertiser-chosen word present in a content file by

linking said at least one advertiser-chosen word to said advertiser web page." Bull

does not teach at least these features.

Bull teaches that "ads/coupons are inserted alongside displayed data (text,

picture, or index displays...." See col. 9, lines 37-39. Further, Bull teaches that its

system may "cause an advertisement/coupon to be added into the display." See col.

12, lines 15-16. However, these teachings of Bull disclose inserting or adding an ad to

a display in **addition** to displayed data. Bull, however, fails to disclose converting a

existing word into an advertisement. Therefore, Bull does not disclose Applicants'

claimed "ad server," which provides "a hypertext anchor *to convert at least one existing*

advertiser-chosen word present in a content file by linking said at least one advertiser-

chosen word to said advertiser web page," (emphasis added) as recited in claim 1.

Moreover, the Examiner has not demonstrated that Bull teaches at least these

features. In the Office Action, the Examiner cites col. 1, lines 30-32, which state "On the

World Wide Web (WWW), a technology called hypertext allows Internet addressable resources to be connected, or linked, to one another." Accordingly, <u>Bull</u> teaches placing hypertext links into documents. This teaching, however, does not disclose providing "a hypertext anchor *to convert at least one existing advertiser-chosen word present in a content file* by linking said at least one advertiser-chosen word to said advertiser web page," (emphasis added) as recited in claim 1.

The Examiner also cites col. 3, lines 56-58, which discloses "Selected text can be 'expanded' at any time to provide other information. These words are, thus, linked to other documents." This teaching merely discloses expanding an index, which may include hyperlinks. See also col. 3, lines 57-58. This teaching, however, does not disclose providing "a hypertext anchor *to convert at least one existing advertiser-chosen word present in a content file* by linking said at least one advertiser-chosen word to said advertiser web page," (emphasis added) as recited in claim 1.

Based on these allegations, the Examiner concludes "the reference *appears* to teach that ads may be presented either by literal insertion or by hyperlink" (emphasis added). See Office Action, page 4. Applicants disagree. The Examiner has not pointed to any teaching in the reference that discloses at least providing "a hypertext anchor *to convert at least one existing advertiser-chosen word present in a content file* by linking said at least one advertiser-chosen word to said advertiser web page," (emphasis added) as recited in claim 1.

Furthermore, even if the Examiner's allegation were true, which Applicants dispute, merely inserting ads by hyperlink also does not teach "*convert[ing] at least one existing advertiser-chosen word present in a content file* by linking said at least one

-13-

advertiser-chosen word to said advertiser web page," (emphasis added) as recited in claim 1. Since the Examiner has not pointed to any teaching in Bull that discloses all of the claimed features of Applicants' "ad server," Bull does not anticipate claim 1. The Examiner should therefore withdraw the rejection of claim 1, and claims 2 and 4-6, which depend therefrom, and allow the claims.

The Examiner rejected independent claims 9, 21, and 24 under the same reasoning. These claims, while of a different scope, include recitations similar to allowable claim 1. Accordingly, the Examiner should withdraw the rejection of claims 9, 21, and 24. Dependent claims 10 and 12-13, which depend from allowable independent claim 9, are also allowable.

Independent claim 31 recites a method including, among other steps, "displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink." Bull does not teach at least this feature of claim 31.

The Examiner admits "Bull et al. does not explicitly teach (independent claim 31) displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink" (emphasis in original). See Office Action, page 4. The Examiner then alleges that principles of inherency make up for this admitted deficiency of Bull. Applicants disagree.

MPEP § 2112.02 explains that, "[u]nder the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently

perform the claimed process." See MPEP § 2112.02, citing *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). The Examiner cites that <u>Bull</u> "teaches clicking on a URL ... to access a Web page." See Office Action, page 4. As a result of this teaching, the Examiner alleges that "[t]he mouse pointer must inherently be positioned over the URL link in order to activate said link by clicking on it."

However, the Examiner has not demonstrated that <u>Bull</u> teaches "displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink," as recited in claim 31. Applicants further disagree that the principles of inherency apply, because nothing in <u>Bull</u> indicates that it would "necessarily perform the method claimed," as required by MPEP § 2112.02. Instead, <u>Bull</u> only discloses clicking a URL, and not "displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink," as recited in claim 31. Accordingly, the Examiner has not shown that <u>Bull</u> anticipates all of the features of claim 31. The Examiner should therefore withdraw the rejection and allow the claim.

Applicants respectfully traverse the rejection of claims 3, 7, 11, 14, 15, 22, and 25 under 35 U.S.C. § 103(a) as obvious over <u>Bull</u>. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. *See* M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success

must exist. *See* M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. *See* M.P.E.P. § 2143 (8th ed. 2001).

Claims 3 and 7 depend from claim 1; claims 11, 14, and 15 depend from claim 9; claim 22 depends from claim 21; and claim 25 depends from claim 24. As discussed above, Bull does not teach every element of independent claims 1, 9, 21, and 24. Accordingly, Bull does not disclose or suggest claims 3, 7, 11, 14, 15, 22, and 25 at least due to their dependence from allowable claims. The Examiner should therefore withdraw the rejection at least for the reasons given above.

In addition, Applicants again traverse the Examiner's taking of Official Notice and respectfully disagree with the Examiner's contention that the prior traversals found in the Request for Reconsideration filed November 1, 2004, and the Amendment filed January 27, 2005, were insufficient. Applicants again respectfully request that the Examiner provide the explicit basis on which the Examiner regards the matter as subject to Official Notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made, or else withdraw the rejection.

Applicants respectfully traverse the rejection of claims 8, 16, 23, and 26 under 35 U.S.C. § 103(a) as being obvious over Bull in view of Kirsch. Claim 8 depends from claim 1, claim 16 depends from claim 9, claim 23 depend from claim 21, and claim 26 depends from claim 24. As discussed above, Bull fails to teach or suggest every element of claims 1, 9, 21, and 24 and their dependent claims. Furthermore, Kirsch does not compensate for the shortcomings of Bull.

The Examiner applies Kirsch, alleging it discloses "linking to said advertiser web page ... using a tracking server system." See Office Action, page 5. Even if this allegation were true, which Applicants do not concede, nothing in the reference discloses or suggests at least "providing a hypertext anchor to convert at least one existing advertiser-chosen word present in a content file by linking said at least one advertiser-chosen word to said advertiser web page," as recited in claim 1, for example. For at least these reasons, the references fail to teach or suggest all elements of claims 8, 16, 23, and 26. Therefore, a *prima facie* case of obviousness has not been established and Applicants request that the Examiner withdraw the section 103 rejections of these claims.

Applicants respectfully traverse the rejection of claims 17-19, 27-29, and 31 under 35 U.S.C. § 103(a) as being obvious over Bull in view of Murray.

Independent claim 17 recites "altering the HTML coding of content for an Internet-displayed file to include a hypertext anchor to convert at least one existing advertiser-chosen word present in the content by linking said at least one advertiser-chosen word to an advertiser web page." Independent claim 27 recites "altering the document file with software to include a hypertext anchor to convert at least one existing advertiser-chosen word present in the document file by linking said at least one advertiser-chosen word to an advertiser document." And independent claim 31 recites "displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink." As discussed above, Bull does not disclose or suggest at least these features.

Furthermore, Murray does not make up for the deficiencies of Bull. Murray merely discloses a system that uses HTML documents to provide content through a browser using pre-defined HTML tags. See col. 5, lines 14-16; col. 6, lines 32-39. Northing in the reference suggests altering the HTML coding to include a hypertext anchor on an existing advertiser-chosen word to link an advertiser web page. Accordingly, Murray does not disclose or suggest all elements of claims 17 and 27, and a *prima facie* case of obviousness has not been established. Dependent claims 18-19 and 28-29 depend from allowable independent claims 17 and 27 and are allowable at least due to their dependence from allowable claims.

Applicants respectfully traverse the rejection of claims 19, 20, 29, 30, and 32 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray and further in view of Kirsch. Claims 19 and 20 depend from independent claim 17. Claims 29 and 30 depend from independent claim 27. Claim 32 depends from independent claim 31. As discussed above, Bull in view of Murray does not disclose or suggest claims 17, 27, and 31. Nor does Kirsch make up for the deficiencies of Bull and Murray. Accordingly, claims 19, 20, 29, 30, and 32 are allowable at least due to their dependence. The Examiner should therefore withdraw the rejection of these claims.
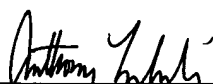
CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration

and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 11, 2005   By:_____
                                            Anthony J. Lombardi
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